SEE COPY

SEP 4 1973

IN THE

Supreme Court of the United States

OCTOBER TERM, 1973

No. 73-131

PENN YAN BOATS, INC.,
Petitioner,

v.

SEA LARK BOATS, INC.,
DON'S MARINE CENTER, INC., AND
DONALD L. WOLLARD,
Repondents.

REPLY BRIEF IN SUPPORT OF PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

WILLIAM K. KERR
277 Park Avenue
New York, N. Y. 10017
Attorney for Petitioner

Of Counsel:
ALBERT E. FEY

August 31, 1973

IN THE

Supreme Court of the United States

OCTOBER TERM, 1973

No. 73-131

PENN YAN BOATS, INC.,
Petitioner,

v.

SEA LARK BOATS, INC.,
DON'S MARINE CENTER, INC., and
DONALD L. WOLLARD,
Respondents.

REPLY BRIEF IN SUPPORT OF PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

Petitioner Penn Yan Boats, Inc. submits this reply brief to refute two contentions which are fundamental to respondents' opposition to the petition.

Questions 1 and 2

Respondents' Brief is wrong when its says (pp. 1-5, 13-14) that the prior art Higgins patent was not received in evidence during the trial of this action. The District Court's Clerk's List of Plaintiff's Exhibits, reproduced in the appendix to this reply brief, shows that Plaintiff's Exhibit 44, which included the Higgins patent, was re-

ceived in evidence during the trial of this action on November 21, 1971.

Moreover, Plaintiff's Exhibit 44, the binder of prior art references including the Higgins patent, also contained the 1929 *Sandpiper* publication which respondents admit (brief, pp. 8-10) is in evidence. And finally, respondents specifically conceded in their brief before the Court of Appeals that the Court should not refrain from considering the Higgins patent (petition, p. 7n).

In light of all of this, it is footless for respondents to urge repeatedly upon this Court that the significant Higgins prior art reference is not properly before it.

Question 3

Respondents' Brief is wrong also when it says (pp. 7-8, 17-18) that petitioner's inboard power means were held by the District Court to be the equivalent of the outboard power means disclosed in the Wollard patent. The findings and conclusions entered by the District Court do not even include the words "equivalent," "equivalence" or "equivalency." They do not include in words or in substance any statement that Penn Yan's inboard tunnel power means "performs substantially the same function in substantially the same way to obtain the same result [as the outboard power means of the Wollard patent]", *Graver Mfg. Co.* v. *Linde Co.*, 339 U. S. 605, 608 (1950), a *sine qua non* for a holding of patent infringement under the doctrine of equivalents.*

Instead, the District Court's findings characterize petitioner's inboard power means as a "literal infringement" (FF 20) of the "means" claims in suit. But literal

*The Court expressly refrained from making this essential finding on the question of equivalents, believing—erroneously—that it was "unnecessary to determine" this question. (FF 36)

infringement is a legal impossibility here in view of (1) respondents' repeated admissions that the Wollard patent fails to describe or illustrate inboard power means (e.g., brief, p. 7), and (2) 35 U. S. Code § 112's requirement that a "means" clause in a patent claim is literally infringed only when the challenged device literally corresponds to what the patent's specification shows and describes.

This fundamental error and respondents' inability to deal with it on the merits, proclaim the need for this Court to clarify the proper construction of "means" expressions in patent claim under § 112—a subject on which it has never spoken.

CONCLUSION

Penn Yan's petition presents important questions regarding administration of the patent laws in the Fifth Judicial Circuit. Wollard's long brief devoted to the merits of its case offers no persuasive reason why these questions should not be resolved now.

A writ of certiorari should issue.

Respectfully submitted,

WILLIAM K. KERR
277 Park Avenue
New York, N. Y. 10017
Attorney for Petitioner

Of Counsel:
ALBERT E. FEY

August 31, 1973

Clerk's List of Plaintiff's Exhibits

CASE NO. 71-S-Civ-W-11

JUDGE W. C. MCHARTE V.C. JURY or (NON-JURY)

DATES OF TRIAL 11/23-

VERDICT RENDERED

JUDGMENT RENDERED 72-3027.

PLTF.	EXHIBITS	DATE RECEIVED
X	1-R. B. STUART - PLAINTIFF BOAT	NOV 23 1971
X	2- PHOTO. PROPELLER AND SHAFT	NOV 23 1971
X	3- PENN YAN U.S.A. WAR CONTRACTOR	NOV 23 1971
X	4- LETTER DATED 5-1-61 TO CURTISS-WRIGHT CORP.	NOV 23 1971
X	5- INVOICE CURTISS-WRIGHT CORP	NOV 23 1971
X	6- ORDER AS A BUYER	NOV 23 1971
	6- COPY OF ABOVE	NOV 23 1971
X	7- BLUE PRINT	NOV 23 1971
X	8- " "	NOV 23 1971
X	9- PHOTO AFT END OF BOAT - MAN AT WHEEL	NOV 23 1971
X	10- " MAST ON LIFT	NOV 23 1971
X	11- " AFT END OF BOAT SHOWING PROPELLER	NOV 23 1971
X	12- BLUE PRINT TOP RUDDER	NOV 23 1971
X	13- " RUDDER PLATE	NOV 23 1971
X	14- SHEET - NEW YORK TIMES 6-9-68	NOV 23 1971
X	15- CAPTIVE WATER JETS - NEW PROPULSION SYSTEM	NOV 23 1971
X	16- PROPULSION MECHANISMS REPRINT - THE BOAT WITH ITS PROP IN A POCKET	NOV 23 1971
X	17- INVOICE, PENN YAN BOAT SALES DATED 7-15-68	NOV 23 1971
X	18- ~~FIRST~~ PENN YAN BOOKLET - INTRODUCING TUNNEL DRIVE	NOV 23 1971
X	19- PENN YAN AD	NOV 23 1971
X	20- "	NOV 23 1971
X	21- PLACARD PENN YAN TUNNEL DRIVE	NOV 23 1971
X	22- LETTER DATED 6-18-69 TO DONALD WILLARD	NOV 23 1971
X	23- APPLICATION, LETTER COMMISSIONER OF PATENTS CERTIFICATE NO 4558C	NOV 23 1971
X	24- INTEROFFICE COMMUNICATION FROM ~~[illegible]~~ THOMAS NICHOLS TO PENN YAN	NOV 23 1971
X	25- Letter to Mr. Winston dated January 19, 1971	NOV 23 1971
X	26- Unsigned ltr from Don Willard	NOV 23 1971
X	27- Letter dtd 9-21-69 from Don Willard	NOV 23 1971
X	28- Patent # 3,469,557 Inventor Donald Willard	NOV 23 1971
X	29- Certified Patent # 3469557	NOV 23 1971
X	30 Letter dated November 12, 1969 to Mr. Robert Stuart	

CASE NO. 71-5-CIV-WM

JUDGE W. C. MEHRTENS JURY or (NON-JURY)

DATES OF TRIAL 11/22-

VERDICT RENDERED

JUDGMENT RENDERED

EXHIBITS

		DATE RECEIVED
x	31- Letter to Al Moreau dated 2/27/70	NOV 23 1971
x	32- Letter to Robt Stewart fr. Sea Sank Boat Corp.	NOV 23 1971
x	33- Boating Magazine dated February 1969	NOV 23 1971
x	34 Jim Machin from The Sea Sank Tunnel-Stern	NOV 23 1971
x	35 Photo 3x5 Stern	NOV 23 1971
x	36. Photo - 8x10 Boat on Hoist	NOV 23 1971
x	37. Hatch of Boat Penn Yan Boats	
x	38. Photo 8x10 Stern of Boat	NOV 23 19
x	39 Hatch - Stern of Boat Penn Yan Boats	
x	40. Xerox Copy of Tunnel Drive Plate Salamander 76	NOV 23 19
x	41 Color Photo of Model + Serial # Plate 8x10.	NOV 23 1971
x	42. Sea Sank Boat Corporation - Price List	NOV 23 1971
x	43 Price Art Cited By Patent Office during prosecution of Willard	NOV 24 1971
x	44. " " Letter to Willard Patent Art Cited by Patent Office	NOV 23 19
x	45 Letter dated March 11, 1966 to Palmer Fultz.	NOV 24 1971
x	46. " " " 26, 1966 to Don Willard	NOV 24 1971
x	47. " " June 13, 1966 to Palmer Fultz.	NOV 24 1971
x	48. " " July 27, 1966 to Don Willard.	NOV 24 1971
x	49 " " October 7, 1966 to " " .	NOV 24 1971
x	50. " " October 7, 1966 to " " .	NOV 24 1971
x	51. " " October 10, 1966 to Palmer Fultz.	NOV 24 1971
x	52. " " November 1, 1966 to Don Willard.	
x	53. " " November 7, 1966 to Palmer Fultz.	
x	54. Invoice dated 11/17/66.	
x	55. Letter dated December 7, 1966 to Palmer Fultz.	NOV 24 1971
x	56. " " January 3 1967 " " " .	
x	57. Invoice dated 3/10/67.	
x	58. Letter dated March 20, 1967 to Don Willard.	NOV 24 1971
x	59. " " June 29, 1967 " " " .	NOV 24 1971
x	60. " " April 8, 1968 " " " .	NOV 24 1971

CASE NO. 71-5-CIV-WM

JUDGE W. O. Mehrtens JURY or (NON-JURY)

Clerk's List of Plaintiff's Exhibits

× 60. " " April 8, 1968 " " " . NOV 24 1971

CASE NO. 71-5-CIV-ICM

JUDGE W. O. McCutcheon JURY or NON-JURY

DATES OF TRIAL 11/22 23 24

VERDICT RENDERED

JUDGMENT RENDERED

EXHIBITS

		DATE RECEIVED
×	61. Letter dtd June 24, 1968 to Palmer Fultz	NOV 24 1971
×	62. Message from Palmer Fultz, Dons Marine Center	NOV 24 1971
×	63. Letter dtd June 27, 1968 to Don Wallard.	NOV 24 1971
×	64. " " Oct 18, 1968 " " " .	NOV 24 1971
×	65. " " Mar 25, 1969 " " " .	NOV 24 1971
×	66. " " May 9, 1969 " " .	NOV 24 1971
×	67. " " May 23, 1969 " " .	NOV 24 1971
×	68. " " June 20, 1969 to Palmer Fultz.	NOV 24 1971
×	69. " " Sept. 21, 1969 to " " .	NOV 24 1971
×	70. " " Dec 3, 1969 to " " .	NOV 24 1971
×	71. " " Jan 15, 1970 to Don Wallard.	NOV 24 1971
×	72. Invoice of Don's Marine Center #5048	NOV 23 1971
×	73. Letter dtd Aug. 13, 1970 to Palmer Fultz.	
×	74. Notice of Receipt of Patent - Liberace.	
×	75. Letter dtd Aug 17, 1970 to Don Wallard.	
×	76. Patent News - U.S. Dept of Commerce,	OUT NOV 24 1971
×	77. Section 713.04 of Manual of Patent Examining Procedure	OUT NOV 24 1971
×	78. Affidavit Overcoming Rejections	OUT NOV 24 1971
×	79. General Information and Correspondence	OUT NOV 24 1971
×	80. Sketch - Handdrawn in Courtroom by Mr. VanPelt	NOV 23 1971
×	81 2700 Sea Sark Literature + Price List	NOV 23 1971
×	82 2300 Sea Sark Literature + Price List	NOV 23 1971
×	83 2700 " " " " " "	NOV 23 1971
×	84 2700 " " " " " "	NOV 23 1971
×	85 3100 " " " " " " .	NOV 23 1971
×	86 2250-2300 Sea Sark Literature + Price List	NOV 23 1971
×	87 Sea Sark Literature	NOV 23 1971
×	88 Sea Sark Literature	NOV 23 1971
×	89 19' " "	NOV 23 1971
×	90 Dons Marine Storage, Literature	NOV 23 1971
×	91 Deposition of Ellis M Sluiter	NOV 23 1971
×	92 Photo 3x5	NOV 23 1971

CASE NO. 71-5-CIV-WM

JUDGE W.D. McCuen JURY or NON-JURY

DATES OF TRIAL

VERDICT RENDERED

JUDGMENT RENDERED

EXHIBITS

	Plaintiffs	DATE RECEIVED
X	93 Color Photo 8"X10" of "Big C" Prop.	NOV 23 1971
X	94 " " " " " " .	NOV 23 1971
X	95 " " " " " " .	NOV 23 1971
X	96 Tim Behavior of Planing Craft - Chapter 30	NOV 23 1971
	97 Page 21 of Naval Architecture of Planing Hulls	NOV 23 1971
X	98 Letter dtd October 18 1966 Re Locket 6420 - Novelty Search	NOV 24 1971
X	99 Letter dtd 2-6-67 to Palmer from Virginia Welland	NOV 24 1971
X	100 Certificate for Patent on Tunnel Design	NOV 24 1971
X	101. Letter June 27, 1965 to Don Welland	NOV 24 1971
	102. Letter dtd 3/16/67 to M. Fitz	NOV 24 1971
X	103. Diagram of Boat -1	NOV 24 1971
	104. Document of Ellen Lee Welland	NOV 24 1971
X	105. Sketch of Boat	NOV 24 1971
X	106. Patent Application & Section	NOV 24 1971

4a

Clerk's List of Plaintiff's Exhibits

SUPR

MARY DONA

COMM

132